

**Remarks/Arguments:**

Claims 14-27 were pending in the application. Applicants note that the Office incorrectly listed claims 1-27 as pending. With this amendment, Applicants have amended claims 14, 24, 25 and 27, canceled claim 23 and added new claims 28-32. Claims 14-22 and 24-32 are pending in the application.

Independent claims 14, 24 and 25 are amended to include the features of dependent claim 23. Claim 27 has been amended to be dependent on independent claim 25. Support for new claims 28-32 can be found in the originally filed specification, for example at page 8, lines 33-36. No new matter has been added.

Claims 14-27 stand rejected under 35 U.S.C. § 102(b) as anticipated by WO 02/42537 ("WO '537") or WO 01/56694 ("WO '694"). Claims 14-27 also stand rejected under 35 U.S.C. § 103(a) as unpatentable over WO '537 or WO '694. Claims 14-27 stand provisionally rejected for obviousness-type double patenting over claims of copending Application Nos. 10/538,341, 10/192,537, 10/537,651 or 10/432,510. Applicants respectfully submit that the currently pending claims are patentable over the cited references for at least the reasons set forth below.

**Response to Rejections**

The Office asserts that claims 14-27 are anticipated by WO '537 or WO '694. Specifically, the Office cites to the abstract and claims of each of WO '537 and WO '694. The Office alleges that "[e]ach of the references discloses a catalyst which is used in the esterification reaction prepared from the same components as claimed by applicants." (Office Action, page 6). The Office contends that because the disclosed amounts, "i.e. moles per mole . . . , are expressed differently . . . it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious." (Office Action, page 6). Applicants submit, however, that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131, (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Contrary to the Office's assertions,

Applicants submit that independent claims 14, 24 and 25 include at least one feature neither disclosed nor suggested by either of WO '537 or WO '694.

Specifically, Applicants' invention, as recited in independent claims 14, 24 and 25, include the feature of: (d) a compound of zinc. Applicants submit that neither WO '537 nor WO '694 disclose or suggest the use of a catalyst, as recited in claims 14, 24 and 25, that comprises the reaction product of the previously claimed constituents a) through c) and a compound of zinc. For at least this reason, Applicants submit that independent claims 14, 24 and 25 are patentable over WO '537 and WO '694.

Moreover, the Office asserts that "[e]ach of the references discloses a catalyst which is used in the esterification reaction prepared from the same components as claimed by applicants except for the particular amounts and parameters, i.e. ranges as claimed or comprising the additional moieties as noted in the dependent claims 18-27." (Office Action, page 9). The Office contends that it would have been obvious to one of ordinary skill in the art to employ particular amounts and/or parameters absent a showing of criticality, or to include the addition of alcohols, dihydric alcohols, or hydroxyl carboxylic acid, components found in the dependent claims, as an unobvious selection commonly used for esterification process/processes.

Applicants submit, however, that neither WO '537 nor WO '694 disclose or suggest the use of a catalyst, as recited in claims 14, 24 and 25, that comprises the reaction product of the previously claimed constituents a) through c) and a compound of zinc. Nor does either reference suggest the use of zinc in a catalyst for esterification purposes. Significantly, the Office also failed to establish why it would have been obvious to further include zinc, as recited in now canceled claim 23 (now included in claims 14, 24 and 25), as a component in an esterification catalyst in its rejection. Applicants submit, therefore, that the Office has failed to establish a *prima facie* case of obviousness and that the rejections of record must be withdrawn.

Claims 15-22, and 26-32 are also patentable over WO '527 and WO '694 for at least the reasons that claims 14 and 25, from which they depend, are patentable, but may be patentable for additional reasons as well.

### **Response to Obviousness-Type Double Patenting Rejections**

The Office provisionally rejects claims 14-27 under obviousness-type double patenting over claims of copending Application Nos. 10/538,341, 10/192,537, 10/537,651 or 10/432,510. The Office asserts that "[e]ach of the applications claims a catalyst suitable for use in an esterification reactions [*sic*] which may include the reactants and moieties as claimed by applicants." (Office Action, page 10).

As a preliminary matter, Applicants submit that Application No. 10/192,537 is no longer copending but has issued as U.S. Patent No. 6,762,314. The double patenting rejection, if proper, would therefore no longer be "provisional." Moreover, Application No. 10/432,510 and the present application are not commonly owned as defined in the M.P.E.P. § 706.02(l)(2)(I).

Notwithstanding the above, Applicants submit that the currently pending application is patentable over these cited applications. Specifically, Applicants submit that with regard to Application Nos. 10/192,537 and 10/432,510, Applicants' invention, as recited in independent claims 14, 24 and 25, includes the feature of a catalyst suitable for use in an esterification reaction which comprises the reaction product of, among other features, (d) a compound of zinc. Applicants submit that because neither of these cited applications include such feature, Applicants' claimed invention is patentable over each of these applications.

Furthermore, regarding Application Nos. 10/538,341 and 10/537,691, Applicants submit that because these double patenting rejections are provisional rejections, Applicants respectfully submit that such double patenting rejections will be addressed upon allowance and issuance of one or more of the applications.

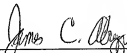
Appln. No.: 10/574,976  
Amendment Dated June 19, 2008  
Reply to Office Action of March 19, 2008

JMYS-141US

## Conclusion

In view of the amendments and arguments set forth above, Applicants submit that the currently pending application is in condition for allowance. Notice to this effect is earnestly solicited.

Respectfully submitted,



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Attachment: Abstract

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